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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/829,511	04/22/2004	Rangarajan Sundar	P1070 US	7340

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MEDTRONIC VASCULAR, INC
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SANTA, ROSA, CA 95403

EXAMINER

DOWE, KATHERINE MARIE

ART UNIT	PAPER NUMBER
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3734

MAIL DATE	DELIVERY MODE
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08/21/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/829,511	Applicant(s) SUNDAR, RANGARAJAN	
	Examiner KATHERINE M. DOWE	Art Unit 3734	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 July 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) 11-32 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The following is in response to the amendment filed July 28, 2009 after the Final Rejection mailed May 28, 2009.
2. Claims 1-33 are currently pending, with claims 11-32 withdrawn from consideration.

Response to Amendment

3. The declaration filed on July 28, 2009 under 37 CFR 1.131 is sufficient to overcome the Rypacek et al. (US 2003/0219562) reference.
4. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

Double Patenting

5. Claims 1-10 and 33 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 3 of copending Application No. 10/827,817. In the copending application, claim 3 is dependent on claim 1. For double patenting to exist as between the rejected claims and copending application claim 3, it must be determined that the rejected claims are not patentably distinct from claim 3. In order to make this determination, it first must be determined whether there are any differences between the rejected claims and claim 3 and, if so, whether those differences render the claims patentably distinct.

Claims 1-10 and 33 recite a “catheter” (see line 2 of claim 1 of the copending application as amended July 20, 2009), a balloon operably attached to the catheter” (see line 3 of claim 1 of the copending application), “a stent disposed on the balloon” (see line 4 of claim 1 of the patent), “a silane layer” (see lines 8-9 of claim 1 of the copending application), and “a coating disposed on the silane layer” (see lines 6-7 of claim 1 of the copending application) including “a therapeutic agent” (see lines 1-2 of claim 3 of the copending application) and a “polymer” (see line 10 of claim 1 of the copending application)

It is clear that all the elements of claims 1-10 and 33 are to be found in claim 3 (as it encompasses claim 1). The difference between claims 1-10 and 33 of the application and claim 3 of the copending application lies in the fact that the copending application claim includes many more elements and is thus much more specific. Thus the invention of claim 3 is in effect a “species” of the “generic” invention of claims . It has been held that the generic invention is “anticipated” by the “species”. See *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993). Since claims 1-10 and 33 are anticipated by claim 3 of the copending application, it is not patentably distinct from claim 3.

6. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

Art Unit: 3734

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-10 and 33 are rejected under 35 U.S.C. 102(b) as being anticipated by Rowland et al. (US 5,356,433). Rowland et al. disclose a stent disposed on a balloon catheter (col 2, ll 64-68). The stent comprises a stainless steel frame (col 4, ll 35-39), an amino silane layer (col 4, ll 40-62) disposed on the stent, and a polymer coating layer including a therapeutic agent disposed on the silane layer (col 5, ll 22-64).

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to KATHERINE M. DOWE whose telephone number is (571)272-3201. The examiner can normally be reached on M-F 8:30am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Todd Manahan can be reached on (571) 272-4713. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3734

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Katherine Dowe
August 17, 2009

/K. M. D./
Examiner, Art Unit 3734

/Todd E Manahan/
Supervisory Patent Examiner, Art Unit 3734